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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/757,205	01/14/2004	Ann C. Merenda	POU92000085US3	3572				
7590 04/13/2007								
IBM Corporation Intellectual Property Law 2455 South Road, P386 Poughkeepsie, NY 12601		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>PONIKIEWSKI, TOMASZ</td></tr></table>			EXAMINER	PONIKIEWSKI, TOMASZ		
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2165								
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE						
3 MONTHS	04/13/2007	PAPER						

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/757,205

Applicant(s)

MERENDA ET AL.

Examiner

Tomasz Ponikiewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12-March-2007 has been entered.

2. The amendment filed on 12-March-2006 has been received and entered. Applicant's amendment has overcome previous claim rejections under 112. Claims 1-45 are pending.

### ***Claim Objections***

3. Claims 1, 16, 31, 35, 36, and 45 are objected to because of the following informalities:

Claims 1, 16, 31, 35, 36, and 45 recite the word "for" in the body of the claims. It indicates intended use and as such does not carry patentable weight. The word could be changed to recite "to". The limitations following the phrase "for" describes only intended use but not necessarily required functionality of the claim. Limitations following the phrase "for" do not carry patentable weight, which cause the claims to

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appear as a series of non-functional descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form. For example, claim 16 recites "creator for" should be "creator to" or "creator that" and in claim 31 "code for" should be "code to" or "executable code".

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 16 and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 16 and 31 do not list any hardware (i.e. computer) tied to the steps in order to operate the steps of the claims therefore resulting in software only implementation. Claim 31 needs a computer or processor for the code to perform its functionality. Computer code can't exist on its own, it needs to be run or stored on a computer. The Specification does not support the claim language of "computer readable medium". The specification directs to "computer readable code means" in paragraph 0049.

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Claim 16 recites a "system" in the preamble. While the body of the claim lists modules, separator, creator, receiver, finder, which are software only, furthermore the specification does not list the system to include hardware; therefore the component of the "system" appear to be software only. The word "system" is not enough to infer the hardware components that make the system. A system needs to have supporting information about the components that are part of it and the claims should include indication that those components are in use.

Dependent claims carry the same deficiency.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 10-20, 25-34, 40-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over de l'Etraz et al. (US 6,073,138) in view of Ho (US 6,148,342).

As per claims 1, 16, 31 de l'Etraz et al. is directed to accessing data records in a private data set having restricted access, the records in the private data set being accessible only by authorized users (column 5, lines 61-62), the method comprising the steps of:

separating a data record into a public data record stored in a public data set and a private data record stored in a private data set (figure 1a, elements 102a and 104a)

creating a logical link logically relating the public data record with the private data record (column 10, lines 47-65, wherein both databases are relational databases which are organized into relational tables and as such are logically linked, by use of ownerID);

receiving a request from a user to perform a predefined operation using information from the private data record, the request comprising information from the public data record and said logical link, the user not authorized to access the private data set (column 5, lines 52-56);

in response to said request, finding the private data record using the information from the public data record received from the user in combination with the logical link (column 5, 55-63);

and performing the predefined operation using the private data record (column 5, lines 55-59).

de l'Etraz et al. does not teach without the user having read access to the private data set.

Ho teaches without the user having read access to the private data set (column 2, lines 46-56)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the de l'Etraz et al. by teachings of Ho to include without the user having read access to the private data set because it prevents unauthorized users from accessing confidential information (Ho; column 1, lines 18-19).

As per claims 2, 17, 32 de l'Etraz et al. is directed to the logical link comprises a key value stored in the public data record and the private data record (column 11, lines 1-4).

As per claims 3, 18, 33 de l'Etraz et al. as modified is directed to the information from the public data record received from the user comprises a key value stored in the private data record (column 11, lines 3-4, wherein key value is stored in a field denoted by "a").

As per claims 4, 19, 34 de l'Etraz et al. as modified is directed to the predefined operation comprises analysis of data in a plurality of private data records (column 5, lines 55-63).

As per claim 5, 20, 35 de l'Etraz et al. as modified is directed to the further step of forwarding the results of the analysis to the user (column 5, lines 55-63).

As per claim 10, 25, 40 de l'Etraz et al. as modified is directed to the performing the predefined operation step is performed only when a required condition is satisfied (column 8, lines 44-67).

As per claim 11, 26, 41 de l'Etraz et al. as modified is directed to the required condition is based upon information in the private record (column 8, lines 50-55).

As per claim 12, 27, 42 de l'Etraz et al. as modified is directed to the private data record comprises data regarding any one of a link ID, a key, a consumer or an enterprise (column 11, lines 1-4).

As per claim 13, 28, 43 de l'Etraz et al. as modified is directed to the public data record comprises data regarding any one of a link ID, a key, a consumer or a product (column 11, lines 1-4).

As per claims 14, 29, 44 de l'Etraz et al. as modified is directed to the performing the predefined operation step comprises the further step of retrieving data from any one of the private data record or the public data record (column 17, lines 2-13).

As per claims 15, 30, 45 de l'Etraz et al. as modified is directed to forwarding the retrieved data to the user (column 7, lines 28-31, wherein the data is in the form of web page).

8. Claims 6-9, 21-24, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over de l'Etraz et al. (US 6, 073,138) in view of Ho (US 6,148,342) and further in view of Scroggie et al. (US 6,014,634).



As per claims 6, 21, 36 de l'Etraz et al. as modified still does not teach performing the predefined operation comprises the further steps of:

using information from the private data record as a network address;

Scroggie et al. teaches performing the predefined operation comprises the further steps of:

using information from the private data record as a network address (Scroggie et al., column 12, lines 50-53);

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include using information from the private data record as a network address because it would allow contact or update between entities (Scroggie et al., column 4, lines 20-30).

de l'Etraz et al. as modified does not teach transmitting a message to the network address.

Scroggie et al. teaches and transmitting a message to the network address (Scroggie et al., column 12, lines 57-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include transmitting a message to the network address because it would make contact or update between entities easier and faster (Scroggie et al., column 4, lines 20-30).

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As per claims 7, 22, 37 de l'Etraz et al. still does not teach the message comprises email.

Scroggie et al. teaches the message comprises email (Scroggie et al., column 12, 57-58)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include the message comprises email because e-mail permits contact between entities in an easy and comfortable way (Scroggie et al., column 4, lines 20-30).

As per claims 8, 23, 38 de l'Etraz et al. still does not teach the message comprises message information from any one of the private data record or the public data record.

Scroggie et al. teaches the message comprises message information from any one of the private data record or the public data record (Scroggie et al., column 12, lines 40-47).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include the message comprises message information from any one of the private data record or the public data record because information in the records determine what the message will contain (Scroggie et al., column 2, lines 65-67; column 3, lines 1-9).

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As per claim 9, 24, 39 de l'Etraz et al. still does not teach the message comprises marketing material.

Scroggie et al. teaches the message comprises marketing material (Scroggie et al., column 12, 59-64).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine de l'Etraz et al. as modified by teachings of Scroggie et al. to include the message comprises marketing material because it makes sense to use the invention in a business environment (Scroggie et al., column 2, lines 65-67; column 3, lines 1-9).

### ***Response to Arguments***

9. Applicant's arguments with respect to claims 1-45 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tomasz Ponikiewski whose telephone number is (571)272-1721. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (571)272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tomasz Ponikiewski  
April 5, 2007



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